

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/391,460 Confirmation No.: 8639
Applicant : Barry BARTON *et al.*
Filed : September 8, 1999
Title : FINANCIAL ADVICE AND STRATEGY SYSTEM
TC/Art Unit : 3628
Examiner: : Frantzy POINVIL

Docket No. : 47004.000030
Customer No. : 21967

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference for the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the following reasons.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why Applicants believe that an appeal will succeed are set forth below. This application was filed September 8, 1999. The Examiner issued mailed an initial rejection on March 27, 2002. Applicants responded with an amendment and arguments filed July 29, 2002. In an Office Action mailed October 15, 2002, the Examiner withdrew the prior rejections and asserted new rejections employing different art. Applicants responded with arguments filed January 15, 2003. The Office mailed a final Office Action on February 12, 2003. Applicants responded with amendments and argument filed May 12, 2003. The Examiner refused to enter the amendment. Applicants filed a request for continued examination on August 11, 2003. The Examiner issued an Office Action on November 10, 2003, in which the claims were rejected over U.S. Patent 6,315,196 issued to Richard Bachman (Bachman). Applicants explained the errors in the claim rejections based on Bachman in a response filed January 28, 2004. The

Examiner issued a Final Office maintaining the rejections based on Bachman on April 26, 2004. A interview between the Examiner and the applicant's representatives was conducted on August 24, 2004. Based on the Examiner comments, applicants filed a response with claim amendments on August 26, 2004. The Examiner mailed an Office Action on December 20, 2004, rejecting the claims over Bachman in view of the article by Lee A. Spirer, *When "bad" credit behavior becomes the norm*, Credit World, Jul./Aug. 1997 at 18 (Spirer). Applicants filed a response on July 17, 2005, set forth the reasons why the combination of Bachman and Spirer is improper and why Spirer fails to correct for the deficiencies of Bachman. The Examiner issued an Final Office maintaining the rejection based on Bachman and Spirer on October 6, 2005. Applicant fully responded to the Final Office Action on February 3, 2006. The Examiner issued an Advisory Action maintaining the rejection on March 6, 2006.

Applicants' claims are generally directed to computer systems and methods for providing negotiation advice to a customer service representative to negotiate with an individual delinquent on a debt. The computer system of the claimed invention allows the customer service representative to classify the debtor's economic situation by selecting a descriptive icon on a first graphical user interface. Questions are then displayed is a second graphical user interface regarding the financial situation of the debtor. The customer service representative upon inputting answers to the questions is provided negotiation advice related to alternative payment options most suitable to the debtor's situation. Bachman is directed to a credit protection program. Spirer is brief article applying behavioral science to collection strategies. Neither Bachman nor Spirer teach or suggest several limitations of the claimed invention. The requirements of a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a) are set forth at pages 2-3 of the Response to Final Office Action. The Final Office Action does not set forth a proper *prima facie* case of obviousness. The Examiner acknowledges that Bachman does not detail a process of providing negotiation advice. Spirer provide the details required to suggest applicant's claimed invention to one of ordinary skill in the art. The Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103.

A. Lack of Motivation to Combine Applied References

In the Office Action, it is asserted, "It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Lee Spirer into the system of Bachman in order to easily generate different alternative payment options most

suitable to a particular financial situation of a cardmember or customer because different cardmembers may become delinquent for different reasons such as being unemployed or hospitalized.” Office Action, p. 4. The Office Action points to no suggestion or motivation in the prior art to combine the teachings of Bachman and Spirer. Bachman is not directed to addressing delinquent accounts. Bachman teaches a system of deferring payments to prevent an account from becoming delinquent should any of a number of different specified events occur. There is no suggestion that any teaching in the Spirer article, directed to changes in the credit card collection industry, is applicable to the Bachman system.

B. Claim 1

Bachman fails to show or suggest all of the limitations of claim 1 for the reasons set forth a pages 7-9 of the Response to Final Office Action. Bachman in view of Spirer fails to show or suggest a first graphical user interface (GUI) displayed on a computer including descriptive icons, where the descriptive icons represent one or more financial situations as set forth in claim 1. The Examiner acknowledges that Bachman in view of Spirer does not teach such a first a graphical user interface. The Examiner identifies no suggestion to modify the teaching Bachman to include descriptive icons *representing one or more financial situations* as set forth by claim 1. Bachman in view of Spirer does not show or suggest a second GUI displayed based on selection of one of the descriptive icons. The Examiner does not address the second GUI set forth in claim 1. Bachman in view of Spirer does not show or suggest a GUI comprising one or more questions related to strategies for addressing the financial situation represented by the selected descriptive icon. The Examiner erroneously suggests that Spirer “discloses obtaining financial situations of a cardmember.” Spirer does not does not address providing customer service representative with negotiation advice. Bachman in view of Spirer does not show or suggest any negotiation advice. There is no teaching in Bachman that any customer service representative negotiates with a customer. Bachman does not teach or suggest negotiation advice. Claims 2-7 depending from claim 1 are patentable over Bachman in view of Spirer for at least these reasons.

C. Claim 8

Bachman in view of Spirer fails to show or suggest all of the steps of claim 8 for the reasons set forth at pages 11-12 of the Response to Final Office Action. Bachman in view of Spirer fails to show or suggest a step of retrieving strategy data in response to the selection of a

descriptive icon. The Examiner fails to set forth where the applied art suggests retrieving strategy data. Bachman in view of Spirer fails to show or suggest a step of displaying a second GUI, where one or more question corresponding to the strategy data are displayed. The Examiner does not address the second GUI set forth by claim 8. Bachman in view of Spirer fails to show or suggest a step of retrieving negotiation advice and a step of displaying negotiation advice. Neither Bachman nor Spirer addresses negotiating with a delinquent individual. Neither Bachman nor Spirer show or suggest negotiation advice related to alternative payment options. For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness against claim 8. Claims 9 and 10 depending from claim 8 are patentable over Bachman in view of Spirer for at least these reasons.

D. Claim 11

The Examiner has failed to establish a *prima facie* case of obviousness against claim 11 for the reasons set forth a pages 12-12 of the Response to Final Office Action. Bachman in view of Spirer fails to show or suggest a step of classifying an individual's economic situation by selecting a descriptive icon. There is no need or suggestion in Bachman to choose a category corresponding to a customer's economic situation. Spirer identifies high-level potential behavioral segments and suggests broad strategies for the segments. Spirer includes no details suggesting a step of classifying an individual's economic situation. Bachman in view of Spirer fails to show or suggest a step of ascertaining further circumstances of an individual's economic situation related to questions displayed on a second GUI as set forth by claim 11. The Examiner does not address this step. Bachman in view of Spirer fails to show or suggest a step of inputting answers to said questions. The Examiner does not address a step of inputting answers to questions. Bachman in view of Spirer fails to show or suggest a step of receiving negotiation advice. Neither Bachman nor Spirer show or suggest negotiation advice related to alternative payment options. For at least these reasons, the Examiner has failed to establish a *prima facie* case of obviousness against claim 11. Claim 12 depending from claim 11 is patentable over Bachman for at least these reasons.

E. Claim 13

The Examiner fails to establish a *prima facie* case of obviousness against claim 13 for the reasons set forth at pages 14-15 of the Response to Final Office Action. Bachman in view of Spirer fails to show or suggest a first graphical user interface. As set forth by claim 13,

the first GUI displays descriptive icons representing general financial situations. There is no need or suggestion in Bachman of a GUI including descriptive icons representing financial situations because a user of the Bachman system does not choose between financial situations. Bachman in view of Spirer fails to show or suggest a second GUI displaying questions related to strategies for addressing a general financial situation and negotiation advice related to alternative payment options. Spirer does not disclose providing questions/answers as asserted by the Examiner. Bachman in view of Spirer fails to suggest displaying negotiation advice related to alternative payment options. For at least these reasons, the Office Action fails to establish a *prima facie* case of obviousness against claim 13. Claims 14 and 15 depending from claim 13 are patentable over Bachman for at least these reasons.

F. Conclusion

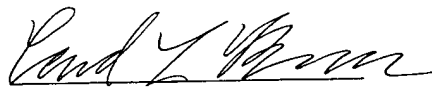
There are clear deficiencies in the *prima facie* case of obviousness presented in the Final Office Action. The applied art does not show or suggest numerous limitation of applicant's claims. In fact, the Examiner is silent regarding several limitations of applicant's claims. The For these reasons, applicants request a pre-appeal brief conference to review these clear deficiencies. More specifically, applicants request that a decision allowing this application or reopening prosecution with a properly constructed, clearly reasoned office action based on relevant art.

Respectfully submitted,

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